

REMARKS

In the Office Action mailed on September 3, 2004, claims 1-4, 6, 8-9, and 15-19 were rejected under 35 U.S.C. §102(b), claims 5-6, 7, and 20 were rejected under 35 U.S.C. §103(a), claim 10 was objected to as being dependent upon a rejected base claim, and claims 21-23 were allowed.

Claim Rejections-35 U.S.C. §102(b)

Claims 1-4, 6, 8 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,737,131 ("Larson '131"). With this Amendment, independent claim 1 recites a conduit racking device that includes a shelf with a plurality of alignment holes arranged in a spaced pattern. The alignment holes are sized to receive electrical conduit and are spaced at least about $\frac{1}{4}$ of an inch from each other to space the conduit. A brace connects to the shelf for attaching the conduit racking device to a building structure. A conduit spacer zone located on the shelf spaces the plurality of alignment holes from the brace. The spacer zone has a width sized to space the electrical conduit from the building structure by at least about $\frac{3}{4}$ of an inch.

Larson '131 discloses a support article for use on a peg board having a plurality of openings (31) for receiving the shanks of headed tools therein. (Figures 1-2 and Col. 2, lines 28 - 33). There is no teaching, suggestion, or disclosure in Larson '131 of (1) alignment holes sized to receive electrical conduit, (2) alignment holes spaced at least about $\frac{1}{4}$ of an inch from each other to space electrical conduit, or (3) a conduit spacer zone located on a shelf that spaces a plurality of alignment holes from a brace and has a width sized to space electrical conduit from a building structure by at least about $\frac{3}{4}$ of an inch. Therefore Larson '131 does not disclose, teach, or suggest each and every feature of the invention recited in claim 1. The rejection of claim 1 under 35 U.S.C. §102(b) should accordingly be withdrawn. Furthermore, since any claim depending from a patentable claim is also patentable, it is respectfully submitted that claims 2-4, 6, and 8-9 are also patentable since independent claim 1 is now in condition for allowance. See MPEP 2143.03, citing In re Fine, 5 U.S.P.Q. 2d (BNA) 1596 (Fed. Cir. 1988).

Claims 15-19 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,815,863 ("Larson '863"). Independent claim 15 discloses a method for arranging conduit into a pattern of parallel spaced conduit. The method includes providing one or more conduit racking devices each having a shelf with a plurality of alignment holes for receiving conduit. The one or more conduit racking devices are secured to a building structure. Conduit is placed through one or more of the alignment holes in each of the one or more conduit racking devices. Larson '863 teaches a garden tool stand for storing tools with relatively long handles, golf clubs, brooms, canes, umbrellas, and the like. (Col. 1, lines 17-20). Larson '863 does not teach, disclose, or suggest placing conduit through one or more alignment holes in one or more conduit racking devices. The Examiner asserts that the Larson '863 garden tool stand can be used following the method recited in claim 15. The relevant inquiry, however, is whether Larson '863 teaches, discloses, or suggests each and every feature of the method recited in claim 15, which, as described above, it does not. Thus, it is respectfully requested that the rejection of claim 15 under 35 U.S.C. §102(b) be withdrawn.

Rejected claims 16-19 depend from claim 15, which is in condition for allowance. Owing to this dependency, the rejection of claims 16-19 under 35 U.S.C. §103(a) should also be withdrawn. See MPEP 2143.03, citing In re Fine, 5 U.S.P.Q. 2d (BNA) 1596 (Fed. Cir. 1988). Moreover, the combination of features recited in claims 17 and 19 are patentable on their own merits. Claim 17 recites the method of claim 15 further including securing the conduit to each conduit racking device. There is no teaching, disclosure, or suggestion in Larson '863 of securing conduit, or the objects disclosed in Larson '863, to each conduit racking device. Claim 19 recites the method of claim 15 further including using the plurality of alignment holes to mark the location of one or more conduit entry holes on a construction surface. There is no teaching, disclosure, or suggestion in Larson '863 of using a plurality of alignment holes to mark the location of one or more conduit entry holes on a construction surface.

Claim Rejections-35 U.S.C. §103

Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Larson '131 in view of U.S. Patent No. 6,278,061 ("Daoud"). Claim 5 depends from amended independent claim 1 and recites the conduit racking device of claim 1 with a shelf having conduit supports disposed at each of the plurality of alignment holes. As discussed above, Larson '131 does not teach, disclose, or suggest each and every element of amended claim 1. In particular, there is no disclosure, teaching, or suggestion in Larson '131 of alignment holes spaced at least about $\frac{1}{4}$ of an inch from each other to space electrical conduit or a conduit spacer zone located on a shelf that spaces a plurality of alignment holes from a brace and has a width sized to space electrical conduit from a building structure by at least about $\frac{3}{4}$ of an inch. Likewise, Daoud, which is directed towards a cable retaining mechanism with a single hollow cavity for centering a cable within a cable port leading into an electrical housing, also does not teach, suggest or disclose either of the above features. Therefore, the combination of Larson '131 and Daoud does not teach, disclose, or suggest each and every element of claim 5. As such, it is respectfully submitted that the rejection of claim 5 under 35 U.S.C. §103(a) should be accordingly withdrawn.

Claim 6 depends from claim 5, which is now in condition for allowance. Owing to this dependency, the rejection of claim 6 under 35 U.S.C. §103(a) should also be withdrawn. See MPEP 2143.03, citing In re Fine, 5 U.S.P.Q. 2d (BNA) 1596 (Fed. Cir. 1988). Moreover, it is respectfully submitted that the combination of features recited in claim 6 is patentable on its own merits. Claim 6 discloses the conduit racking device of claim 5 wherein the conduit supports are rigid tabs that are deformable from a first position planar to the shelf and protruding into the alignment holes to a second position perpendicular to the shelf. The Examiner cites Daoud to provide the rigid tabs of claim 6. However, there is no teaching, suggestion, or disclosure in Daoud of either a rigid tab or a tab that is deformable from a first position planar to the shelf. Rather, Daoud discloses resilient (i.e., non-rigid) projections (20) that are not planar to a shelf in a first position. (Figures 1-4). Thus, the combination of Larson '131 and Daoud does not teach, suggest, or disclose each and every element of claim 6. As such,

it is respectfully submitted that the rejection of claim 6 under 35 U.S.C. §103(a) should accordingly be withdrawn.

Claim 7, which depends from amended claim 1, was rejected under 35 U.S.C. §103(a) as being unpatentable over Larson '131 in view of Larson '863. As discussed above with respect to claim 1, Larson '131 does not teach, suggest, or disclose (1) alignment holes sized to receive electrical conduit, (2) alignment holes spaced at least about $\frac{1}{4}$ of an inch from each other to space electrical conduit, or (3) a conduit spacer zone located on a shelf that spaces a plurality of alignment holes from a brace and has a width sized to space electrical conduit from a building structure by at least about $\frac{3}{4}$ of an inch. Likewise, these features are also not taught, suggested, or disclosed by Larson '863. Thus, since claim 7 depends from amended claim 1, which is now in condition for allowance, the rejection of claim 7 under 35 U.S.C. §103(a) should accordingly be withdrawn. See MPEP 2143.03, citing In re Fine, 5 U.S.P.Q. 2d (BNA) 1596 (Fed. Cir. 1988).

Amended claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Larson '863. Claim 20 depends from claim 19 and recites using the plurality of alignment holes to mark the location of one or more conduit entry holes on an electrical box. There is no teaching, disclosure, or suggestion in Larson '863 of using the Larson '863 garden tool stand to mark the location of one or more conduit entry holes on an electrical box. As such, the rejection of claim 20 under 35 U.S.C. §103(a) should accordingly be withdrawn.

Objection to Claims

Claim 10 was objected to as being dependent on a rejected base claim, but was indicated to be allowable if rewritten in independent form to include all of the features of the base claim. With this Amendment, claim 10 has been amended to include all of the features of independent claim 1. In view of the foregoing, claim 10 is now in condition for allowance.

Withdrawn Claims

Claims 11-14 are canceled pursuant to the election of claims 1-10 and 15-23 made during the August 31, 2004 telephone conversation with the Examiner.

New Claims

New claims 24-26 are added. New claims 24 and 25 depend from amended claim 1 and new claim 26 depends from claim 6. None of the cited references teach, suggest, or disclose the features of claims 24-26. Therefore, claims 24-26 are allowable over the cited art. Consideration and notice to that effect is respectfully requested.

Allowed Claims

The allowance of claims 21-23 is gratefully acknowledged.

Information Disclosure Statement

The Office Action noted that a copy of the advertisement entitled "The Marksman Conduit Layout Tool" listed in the Information Disclosure Statement was not found in the application. Please disregard this advertisement as it was referenced in the Information Disclosure Statement because of claims 11-14, which have since been canceled.


CONCLUSION

With this Amendment all of pending claims 1-10 and 15-26 are in condition for allowance. Reconsideration and notice to that effect is respectfully requested. The Examiner is authorized to charge any additional fees associated with this application or credit any overpayment to Deposit Account No. 11-0982. Any inquiries regarding this application should be directed to David R. Fairbairn at 612-337-9357.

Respectfully submitted,

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